

REMARKS

Claim Status

Claims 1-16 are pending in the Application. The Examiner has rejected claims 1-12, 15, and 16. The Examiner has objected to claims 13 and 14. Applicant has amended claim 1, and has added claims 17 and 18 which are objected to claims 13 and 14 placed in independent form. Applicant believes that the amendment is fully supported by the specification as filed (*see e.g. Application's specification, pg. 2, lines 12 -20*).

Claim Rejections – 35 U.S.C. §102

The Examiner rejected the applicant's claims under 35 U.S.C. §102(b) which states, "A person shall be entitled to a patent unless. . . (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States." For a claim to be rejected under this statute, it must be anticipated by the prior art. Anticipation occurs when every element of the claimed invention is met. *See, Carella v. Starlight Archery & Pro Line Co.*, 804 F.2d 135 (Fed. Cir. 1986) (stating, "[a]nticipation under Section 102 requires 'the presence in a single prior art disclosure of all elements of a claimed invention arranged as in that claim'"); *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675 (1988 Fed. Cir.) (stating, "[f]or a prior art reference to anticipate in terms of 35 U.S.C. §102, every element of the claimed invention must be identically shown in a single reference"); *Helifix Ltd. V. Blok-Lok Ltd.*, 208 F.3d 1339 (Fed. Cir. 2000) (stating, "[t]o be anticipating, a prior art reference must disclose 'each and every limitation of the claimed invention[,] . . . must be enabling[,] and must describe . . . [the] claimed invention sufficiently to have placed it in possession of a person of ordinary skill in the field of the invention'"). In this case, not every element of the applicant's claimed invention is met in the prior art.

Gunn, U.S. Patent No. 4,544,195

The Examiner rejected claim 1 under 35 U.S.C. §102(b) based upon U.S. Patent No. 4,544,195 issued to Gunn ("Gunn '195"). The Examiner's office action stated that Gunn '195 teaches the applicant's claimed apparatus. The applicant respectfully

disagrees with the Examiner's position, but has clarified that the claim applies to the passenger compartment of a motor vehicle.

The applicant's window system comprises a flexible window (10), a soft-cover window frame (20), and an insertable screen (30). Additionally, the insertable screen (30) is matingly coupled to the window perimeter of the flexible window (10). Further, the applicant's claimed apparatus is used for the passenger compartment. For example, a passenger compartment is a space for a traveling in a public or private conveyance (*see 4th ed. Merriam-Webster on-line dictionary*). This window system can be used on vehicles, such as Jeeps or convertibles, that are driven without windows in place.

Gunn '195, however, does not enable and teaches away from Applicant's invention because Gunn '195 is to be used with **the non-passenger area of a pickup truck** for "camping purposes" (*See Gunn '195 lines 36-39*). In fact, the Examiner's office action clearly points out that "Gunn discloses a convertible soft-cover for a camper." Specifically, the 4th ed. of Merriam-Webster on-line dictionary defines **Camp** and therefore **camping** as a stationary activity:

- 1 : to make camp or occupy a camp;
- 2 : to live temporarily in a camp or outdoors -- often used with *out*;
- 3 : to take up one's quarters; and
- 4 : to take up one's position : settle down".

Further, Gunn '195 teaches that the tailgate of the non-passenger area of the pickup truck is moved from an upright closed position downwardly to a horizontal open position making the use of this invention dangerous for travelling of passengers and/or such non-stationary uses destroying the intended function of Gunn '195. While, the camper in Gunn '195 may be temporary (and possibly moved) it is not used as a passenger compartment. Therefore, because Gunn '195 does not enable every element of Applicant's invention and also teaches away from Applicant's invention, Applicant kindly believes that claim 1 has been put in condition for allowance and requests that the objection be withdrawn.

Claim Rejections - 35 U.S.C. § 103

The Examiner rejected Applicant's claims under 35 U.S.C. §103(a).

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

35 U.S.C. §103(a).

As discussed above, Gunn '195 teaches away from Applicant's invention. Therefore, Applicant kindly requests the withdrawal of the §103 objections.

a) The combination of Gunn '195 with Bell (US Patent 5,921,571) does not teach Applicant's invention and would destroy the intended function of Gunn '195.

The Examiner rejected claims 2-12 and 15-16 under 35 U.S.C. § 103(a) as obvious. Specifically, claim 2 was rejected over Gunn '195 in light of Bell (US Patent 5,921,571). The Examiner stated that one of ordinary skill would have been motivated to combine the Gunn '195 patent with other cited inventions disclosed in these patents to create applicant's window system. If a proposal for modifying the prior art in an effort to attain the claimed invention causes the art to become inoperable or destroys the intended function, then the requisite motivation to make the modification would not have existed. *See In re Fritch*, 23 U.S.P.Q.2d 1780, 1783 n.12 (Fed. Cir. 1983). Applicant kindly disagrees with the Examiner's rejections for all of the previous reasons stated and because not only does Gunn '195 teaches away from Applicant's invention, but also it is impermissible to combine Gunn '195 with the Bell (US Patent 5,921,571) since it would destroy the intended function of Gunn '195 (**namely camping**). Specifically, Bell is directed to a trailer or moving vehicle, while Gunn '195 is for camping (i.e. a stationary purpose). The combination of Bell with Gunn '195 would destroy the intended function of Gunn '195.

Therefore, Applicant kindly requests that the rejections be withdrawn to claim 2.

b) Neither Gunn '195 nor the "ordinary skill in the art" or their combination teach or enable Applicant's claims.

The Examiner rejected claims 3, 6, 7, 11, 12, and 15 under 35 U.S.C. § 103(a) as obvious. The Examiner claimed that it would have been obvious to combine the Gunn '195 patent with routine skill in art to produce the objected claims. Applicant does not believe that Gunn '195, alone, or in combination teach or fairly suggest the creation of a window system for a passenger compartment for a motor vehicle. Further and as stated above, Applicant believes that intended function of Gunn '195 (**namely camping**) teaches away from Applicant's invention. Therefore, Applicant kindly requests that the rejections be withdrawn to claims 3, 6, 7, 11, 12, and 15.

c) Neither Gunn '195 nor the "Applicant's Admissions" or their combination teach or enable Applicant's claims.

The Examiner rejected claims 4, 5, 8, 9, and 10 under 35 U.S.C. § 103(a) as obvious. The Examiner claimed that it would have been obvious to combine the Gunn '195 patent with "Applicant's Admissions" to produce the objected claims. Applicant does not believe that Gunn '195, alone, or in combination with Applicant's response teach or fairly suggest the creation of a window system for a passenger compartment for a motor vehicle. Further and as stated above, Applicant believes that intended function of Gunn '195 (**namely camping**) teaches away from Applicant's invention. Moreover, the Examiner agrees that Gunn '195 only supports a combination materials from the housing industry (i.e. stationary residence) with a mobile home or mobile tent (i.e. temporary residence or **camping**), but it does not teach the use with a passenger compartment of a motor vehicle. Therefore, Applicant kindly requests that the rejections be withdrawn to claims 4, 5, 8, 9, and 10.

Conclusion

Applicant believes he has addressed and responded to every point raised in the Examiner's action. For the reasons stated above, Applicant respectfully requests reconsideration of its application.

Art Group: 3612
Examiner: Engle, Patricia L.

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on 2/24/04

By James Venable